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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,554

12/10/2003

Fred J. Molz IV

31132.63

7729

46333 7590 10/29/2007
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EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

10/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,554

Applicant(s)

MOLZ ET AL.

Examiner

James L. Swiger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/26/2007 and phone interview on 10/9/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,8-12,41-48 and 50-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,8-12,41-48 and 50-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20071009
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/26/2007 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, 8-12, 41-42, 50, and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. (US Patent 6,402,750) in view of Zucherman et al. (US 6,652,527).

Atkinson et al. disclose a surgical implant for the spine having a first and second biocompatible implant (see Fig. 4b) that is capable of attachment to the superior and inferior vertebrae, respectively, and that are biocompatible (See Col. 14, lines 35-55). The two attachment devices also provide a distracting force enabling proper spacing

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between the first and second pedicles. The implants may also provide a compressive force. (See Col. 9, lines 28-43.) The device of Atkinson et al. also teaches a prosthetic device that has a means for providing posterior devices (See Col. 23, lines 44-46), and a means for adapting one or more of the devices to the first and second transverse processes for spinous processes for attachment to laminae (as an adjustable arm 114), a means for removing at least a portion of the facet joint (see Col. 13, lines 34-44, inherently describing the use of the drill that removes a portion of the joint for securing the prosthetic device). Atkinson et al. also discloses elasticity based on the material chosen (Col. 10, lines 12-19).

Atkinson et al. disclose the claimed invention except for a surgical implant with a joint component with both components having elongated members enabling the first and second biocompatible members to rotate relative to one another with the flexible member. Zucherman et al. disclose elongated joint members (108 and 114) that permit the spinous processes to move relative to one another (see Col. 4, lines 8-29) and also have holes at one end for the location of the joint (where 102 meets at the center of the two elongated members). Also, the portion 102 and the accompanying nut are considered a connector for the purpose of the joint. It would have been obvious to one having ordinary skill in the art at the time the inventions were made to construct the device of Atkinson et al. having at least joint components that can rotate relative to one another to better secure and angle the fixation device.

Claims 42-48 and 51-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination above as applied to claims 1 and 8, respectively

above, and further in view of Simonson (US Publication 2005/0101956). The combination discloses the claimed invention except for the use of an elastic material either in the joint or connector. Simonson teaches the use of the elastic material that would increase resistance and the connectivity of the device (see paragraph 0020). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Atkinson et al. and Zucherman et al. having at least the elastic material in the joint as taught by Simonson et al. to have better control and connectivity in the fixation device.

Response to Arguments

The previous action dated 7/17/2007 has been withdrawn. This action replaces the previous non-final Office Action, per request of the applicant. See enclosed Interview Summary for further information.

Applicant's arguments filed 4/26/2007 have been fully considered but they are not persuasive. The references in combination are considered to meet the claim limitations as amended including a flexible member with a joint component. It is further noted that with regard to forming a *prima facie* case of obviousness that as stated in *KSR International co. v. Teleflex, Inc. et al.* a person of ordinary skill in the art has good reason to pursue known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance, the fact that a combination was *obvious to try* might show that it was obvious under U.S.C. 103.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



10/19/07

JLS



EDUARDO C. ROBERT
SUPERVISOR, PATENT EXAMINER